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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,506	01/12/2006	Shingo Odajima	270934US0PCT	6838
22850	7590	07/03/2008	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			USELDING, JOHN E	
			ART UNIT	PAPER NUMBER
			4171	
			NOTIFICATION DATE	DELIVERY MODE
			07/03/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/532,506	Applicant(s) ODAJIMA ET AL.	
	Examiner John Uselding	Art Unit 4171	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 6-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-30 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: ____. |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :4/25/05, 7/20/05, 2/21/07, 5/7/07, 8/22/07, 3/14/08, 6/23/08 .

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, Claims 1-5 in the reply filed on 6/23/2008 is acknowledged. The traversal is on the ground(s) that the restriction requirement is improper. This is not found persuasive because there is no special technical relationship linking the claims. The wax composition of claim 7 is the common technical feature and is known in the prior art (Hideyuki et al. JP 07-278510), as stated in the written restriction. Therefore there is a lack of unity.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Zemaitis (2,375,162) and C. C. Ho et al. (Low Glass Transition Temperature Rubber Latex Film Formation Studied by Atomic Force Microscopy)

4. Regarding claim 1: applicant claims a process of mixing wax and a component by applying external force at a temperature lower than the melting completion temperature of the wax. Zemaitis teaches a method of preparing a wax composition by mixing wax with other components at a temperature below the melting point of the wax

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(examples 1 and 2, column 3, lines 14-50). The applicant defines the melting completion temperature as the temperature that the wax starts to melt (paragraph 0054). Therefore a temperature below the melting point of the wax is lower than the melting completion temperature. The mixing occurs in a Werner and Pfleiderer mixer (column 3, lines 44-45). This mixing apparatus uses external force to mix the composition. The examiner notes that any mixing apparatus is going to apply external force to mix a composition.

5. Regarding claim 2: applicant claims the mixing below the melting completion temperature is followed by heating the mixture at or above the melting completion temperature of the wax. Zemaitis teaches that after mixing the wax composition below the melting point of the wax the temperature is raised above the melting point of the wax (examples 1 and 2, column 3, lines 14-50).

6. Regarding claims 3-4: applicant claims that the component mixed with the wax comprises an amorphous polymer and that the temperature during the mixing of claim 1 is at or above the glass transition temperature of the amorphous polymer. Zemaitis teaches mixing natural rubber with the wax (column 3, line 6 and example 2). The applicant has shown that natural rubber is an amorphous polymer (paragraph 0045). Zemaitis teaches that the components can be initially mixed together at room or elevated temperature (column 2, lines 43-46). The glass transition temperature of natural rubber is about -65°C . C. C. Ho et al. (Low Glass Transition Temperature Rubber Latex Film Formation Studied by Atomic Force Microscopy) is being used as an

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evidentiary reference to prove this fact. Room or elevated temperature is well above - 65°C.

7. Regarding claim 5: applicant claims that the polymer is isoprene rubber or natural rubber (claim 5). Zemaitis teaches mixing natural rubber with the wax (column 3, line 6 and example 2).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Uselding whose telephone number is (571)270-5463. The examiner can normally be reached on Monday-Thursday 6:00a.m. to 4:30p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Tarazano can be reached on 571-272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. Lawrence Tarazano/
Supervisory Patent Examiner, Art Unit 4171

John Uselding
Examiner
Art Unit 4171

/JEU/